

REMARKS

The present invention is directed to the field of searching a database of patent documents, for example to determine the novelty or the existence of a particular patent document having technical features relevant to a specific area of invention.

As the Examiner is aware, patent searching basically attempts to parse a specific feature or functioning structure from a broad area of technical information represented in patent documents that usually are classified, for example by a national or international patent classification system and subclassifications of technical features, such as an F-term in addition to key words that are generic to conventional searching of databases outside of the patent field.

A patent search is unique in trying to confidentially search on behalf of a potential inventor to assure that the same elements of the invention do not exist in the prior art or in the case of a third party seeking to invalidate a patent, to attempt to find narrow technical features that the Patent Examiners were not capable of finding when granting claims in an issued patent. Note, revealing the specifics of the search query could alert competitors to the new invention.

Thus, while certain characteristics of logically searching a database of information may be employed, patent literature and the international patent classification system cited in the patents applied against our invention, bear witness to the uniqueness and difficult task that occurs in pursuing either of the above paths for technical information. The U.S. Patent Office has recognized that while broadly searching for key words on a vast database has become more common, that patent protection is granted for unique features in this field. Particularly when they provide a useful and technological practical impact to advance the art.

“Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the

decision-maker must consider the obviousness of the new structure in this light.”

Continental Can Co. USA Inc. v. Monsanto Co., 20 U.S.P.Q. 2d. 1746, 1752 (Fed. Cir. 1991).

In this regard, the present invention as defined in our claims are specifically directed to searching a database of patent document data files. These patent document data files are retrieved and are displayed in a particular manner to assist in performing the search. A specific type of display is made available to a user that enables the user to economically expand and narrow the search fields that may produce useful patent document data files that will also be displayed adjacent the initial search query and each sequential updated search query.

Additionally, another region of the display window simultaneously displays in correlation with the search query and the patent document files a search key list. Thus, three separate windows are displayed to enable a utilization by the user to appropriately modify subsequent search queries, for example by selecting from a third window frequently used search keys, where the search keys have been extracted from the collected patent document data files being displayed in a second window.

A specific extracting unit is configured to extract frequently used search keys specifically from the patent document data files. As can be readily appreciated, a common layman without much knowledge of patent documentation or a professional searcher can advantageously utilize these features of our present invention to progressively parse down the relevant search field and ultimately the relevant patent documentation to reach a conclusion on the purposes of his search goals.

The Office Action, noting the Supreme Court decision of *KSR Int'l Co. v. Teleflex Inc.* and the Examination Guidelines for Determining Obviousness under 35 U.S.C. §103 asserted

that a teaching, suggestion or motivation test while helpful is flexible and an explicit suggesting to combine prior art is not necessary to support a finding of obviousness, citing the case of *Ex Parte Smith*.

The Patent Office, however, does recognize that it still requires an explicit analysis to justify an apparent reason why a person of ordinary skill in the art would want to combine various elements in the same fashion claimed by the patent at issue.

The Board of Patent Appeals recently noted on November 30, 2007 as follows:

It is the Examiner's burden to establish *prima facie* obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Here, we find that the Examiner has not identified all the elements of claim 1, nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention.

Ex parte Karoleen B. Alexander, No. 2007-2698, slip op. at 6 (B.P.A.I. Nov. 30, 2007)

The Office Action basically repeated, verbatim, the previous rejection of May 1, 2007 of our claims on Pages 1-9. However, applicant appreciates the Examiner's specific responses to some arguments on Pages 10-16.

The Office Action rejected Claim 1 over *Whitman et al.* (U.S. Patent Publication 2004/0236736) in view of *Nosohara* (U.S. Patent No. 6,571,241).

Specifically, the Office Action contended that the *Whitman et al.* reference disclosed basically each of the claim elements of Claim 1 and the *Nosohara* reference could be relied upon to teach applying the *Whitman et al.* search technique to searching a database of patent

documents. The Office Action appears to suggest *Whitman et al.* is an omnibus reference that apparently could be a barrier for future patents on searching any type of a database.

The Office Action cited Paragraph 0029 of *Whitman et al.* with a contention that a search refinement method could be implemented within “any type of computer system that provides searching capabilities to a community of users.” Actually, the community of users being referred to is important for establishing a historic basis for this commercial search system provided by a retail outlet on the Internet such as Amazon, as shown in Figure 2. The community of users is defined in Paragraph 0026 as follows:

The present invention provides a search refinement system and method for generating related search phrases (“related phrases”) using a history of search queries submitted to a search engine by a community of users. Briefly, the system generates search phrase data which reflects the frequency with which specific phrases containing key terms have been submitted to the search engine. (underline added)

Thus, the essence of this teaching to a person of ordinary skill in this field is to assist, for example Amazon, to make a product pitch to a user that logs onto their website. In this regard, a history of prior third party search queries submitted to the search engine by a community of prior users (customers) for some predetermined time period of “M days of entries in a transaction log,” see Paragraph 0028, can be presented to the user to copy these search queries.

As the Examiner is aware, applicant’s claims defined patent document data files and the search keys come from these patent document data files, not from earlier searches by a community of prior users. We specifically claim a key selection unit to query the initial search results in the form of patent document data files to remove from those patent document data files frequently used search keys, for example associated with the International Patent Classification System and other technical classification systems.

Thus, it is the specific results of the user's first confidential search query that generates the leads for subsequent modifications of a second search query by the same user. This is necessary to achieve the purposes of a novelty search or an infringement search by a user of the patent document database.

The *Nosohara* reference is directed to a patent search in a foreign language such as, for example Japanese patent documents stored in Japanese. The *Nosohara* reference recognizes that frequently there are not literal translations of an English word into a corresponding Japanese word and for a foreigner to search in such a database, it is necessary that there is an adjustment to alter the English word query to search for Japanese documents.

For this reason, the U.S. Patent Office granted a patent to *Nosohara* for its teaching of using a search expression replacement unit that can correlate a second language expression different from the first language expression. That is, an English search query could also be supplemented with a Japanese search query from a replacement table that can suitably replace the first search expression in a first language with components of a second search expression in a second language, namely in Japanese that would be important in performing a search.

One of the examples disclosed in Column 1, Lines 57-65 is that a common name for a Japanese company such as Subaru in English does not correspond with the actual legal name of that company "Fuji Jukoh" in Japan. Accordingly, the teaching in the *Nosohara* reference would be to substitute the Japanese version to facilitate an appropriate search for looking for patent documents associated, for example with a Subaru car.

As noted above, the Federal Register, Volume 72, Page 57534, second column, was cited for the premise that a motivation, suggestion or teaching reference does not have to be explicit in the prior art. However, a suggestion, motivation or teaching must still be found and the

immediate preceding paragraph to the quoted portion of the Federal Register is actually copied from MPEP §2143.02 as follows:

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). (underline added)

Applying these standards to the obviousness rejection based on the *Whitman et al.* and *Nosohara* reference when further supplemented by any one of the *Vora et al.* (U.S. Patent No. 5,623,652), *Keith, Jr.* (U.S. Patent No. 7,085,766) and *Cabra et al.* (U.S. Patent Publication 2003/0014396), cannot explain what would be the motivation to modify the *Whitman et al.* reference that teaches a search on a commercial retailer's website utilizing the terminology "Dog" that stores searches by third parties "historical query submissions to the search engine" and suggests the related third party phrases previously used.

The Office Action cited Figure 8, Element 810 in Paragraph 0051 of the *Whitman et al.* reference for its rationale and a listing of frequently used search keys adjacent the search condition.

The Office Action contends that our extracting unit can be found in the *Whitman et al.* reference to extract frequently used search keys and our search key list displaying unit disclosing the search keys is equivalent to the related search queries from third parties.

However, our Claim 1 clearly defines in its preamble that we are searching a database of patent document data files with particular types of search keys. The claim elements in the body

of our claim further incorporates our preamble by defining a search unit operable to search a database for at least one patent document data file that satisfies the search query. Our extracting unit then extracts a plurality of frequently used search keys for each of the fields from the patent document data file that is a search result. The fields have already been defined in the preamble including IPC symbol, F term and key word. The extraction unit does not operate on historical search queries from third parties. It operates specifically on the patent document data that is a result of our search query.

Our search key list displaying unit then displays the search keys extracted for each of the plurality of fields defined in the preamble that were extracted by the extracting unit. The user can then select at least one search key from the search keys extracted from the plurality of fields from the patent documents and add the selected search key as an element in a further search query to each of the fields.

The *Whitman et al.* reference does not teach our claim elements, but the Office Action suggests that a data searching apparatus of patent document data files could invade the privacy of third party searchers and list the related search queries. As can be readily expected, neither the USPTO nor any reputable commercial searching service can invade the confidences of their clientele by revealing the confidential interest and activity of unrelated third parties. A person of ordinary skill in the field would not expect to change the function of “third party previous searches” as a teaching to seek search keys from the actual patent documents found nor expect a breach of confidence in revealing third party search queries.

Thus, the lynch pin of the *Whitman et al.* rejection is that related third party searches (Element 810 of Figure 8) are the equivalent of a result of further examining the patent documents produced by our searching unit with an extracting unit operating on these patent

documents to extract search keys relevant from a plurality of fields. However, *Whitman et al.* certainly does not display “a list of the frequently used search keys extracted for each of the plurality of fields” adjacent the search condition in Element 810 of Figure 8.

The MPEP is also adequately clear that even if the references can be combined, there must be an articulated reason with rational underpinning to support a conclusion of obviousness. See MPEP §2143.01, III, IV.

As the Office Action acknowledges, the *Whitman et al.* reference does not teach that the document data files are patent documents, but instead relies upon the *Nosohara* reference to teach that patent document files are known and have a plurality of fields including an IPC symbol, an F term and a key word.

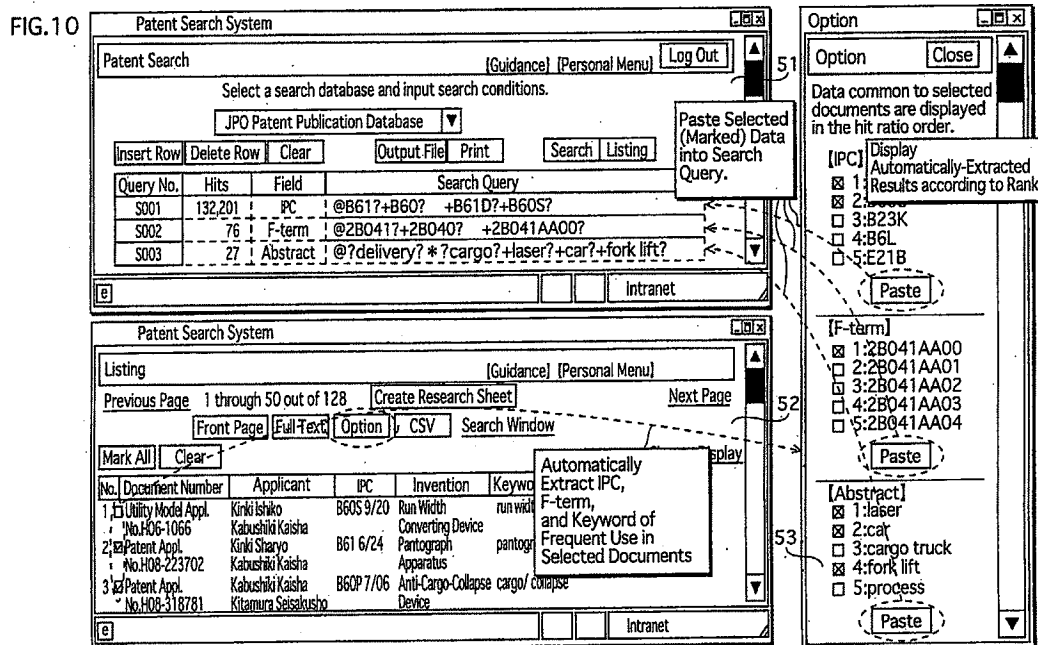
The Office Action asserted that it would be obvious to modify the basic structure of *Whitman et al.* to search patent documents in a variety of languages as suggested by *Nosohara*. *Nosohara* is directed to a search expression replacement section 107 shown in Figure 1 to assist a foreigner to modify words, for example in English such as Subaru, to a more appropriate terminology in Japanese that is not necessarily the identical translation.

Nosohara does not provide any teaching to address the features found in our claim elements that have been erroneously relied upon as taught by the *Whitman et al.* disclosure. It must be presumed that *Whitman et al.* is not about to make a modification that changes the principle of operation of the *Whitman et al.* reference, namely disclosing the related searches from third parties to assist in suggesting other areas of search to find, for example appropriate books on Dogs. A person of ordinary skill in the patent field including an Examiner, would not reveal confidential historical search queries of third parties as suggestions to meet the elements of the current claims.

Additionally, the *Nosohara* reference simply defines the characteristics of patent documents and does not address the purposes or advantages of our present invention as defined in our claims.

Applicant accordingly suggests that there is no reasonable expectation of meeting the actual claims elements in our claims nor of any possibility of producing or replicating our invention by combining these two references without the use of hindsight and also disregarding of the clear teachings of the *Whitman et al.* disclosure.

As disclosed below in Figure 10 of our drawings, we provide three separate windows to disclose respectively an initial search query, patent document data files that are retrieved in response to the search query, and a list of frequently used search keys extracted from the fields relative to the found patent document data files and this search information is provided within three separate windows of information to enable refinements of the initial search in a quick and convenient manner.



The Office Action rejected Claims 2 and 3 over *Whitman et al.* in view of *Nosohara* reference, when further taken in view of *Macke et al.* (U.S. Patent No. 6,249,784). *Macke et al.* was cited for its ability to extract a hit list in the environment of the Genbank database and does not teach the advantageous features related to a patent document data file searching apparatus as defined in our claims, nor does it correct the deficiencies in the *Whitman et al.* disclosure.

The Office Action further rejected Claim 17 over *Whitman in et al.* in view of *Nosohara* and *Murakami et al.* (U.S. Patent Publication 2003/0074671). *Murakami et al.* was cited for displaying a use of a hit ratio in an interactive TV arrangement wherein a viewer could click on a costume of an actress and be able to determine a price and a supplier name. Thus, the *Murakami et al.* reference also does not address the deficiencies mentioned above in the *Whitman et al.* disclosure.

Finally, the *Rising III* (U.S. Patent Publication 2003/0187950) was cited in combination with *Whitman et al.* and *Nosohara*. The Office Action specifically referred to Paragraph 0014, Lines 29-35, to teach a library of query examples that would permit a user to select predefined query elements and a manner of altering or pasting new search metrics into a new search query.

More specifically, *Rising III* is directed to a search of actual visual objects that are digitally represented in an MPEG-7 format to query such a visual base of digital material. *Rising III* appears to be suggestive of the historical search queries of third parties discussed in the *Whitman et al.* disclosure. *Rising III*, however, does not rectify the deficiencies of the principal *Whitman et al.* disclosure in view of our specific claim language submitted herein.

In accordance with 37 CFR §1.116 applicant submits that it has cited sufficient grounds for the allowability of the current claims, and has reduced the number of issues by cancelling Claim 2, and has further amended Claim 1 to clarify that three windows are simultaneously

displayed on the same screen to expedite patent searching wherein the information secured in the initial search query is further supplemented and enhanced by mining information available from the patent documents that are found in response to the initial search query and subsequently refined search queries.

Amendments to Claim 1 are responsive to the description and disclosure in Figure 10 above, and does not add any new matter. Additionally, none of the references of record provide the features set forth in our amended claims.

The amended Claim 1 of the present application is characterized in having a structure in which the following three windows are simultaneously displayed on the same screen: A first window on which “a search query that is a logical formula including an AND search query and an OR search query” is displayed; a second window on which “a list of the one or more patent document data files that are search for based on the search query being displayed on the first window” is displayed; and a third window on which “a list of the frequently-used search keys extracted for each of the plurality of fields included in the one or more patent document data files selected on the second window” is displayed. Furthermore, the amended Claim 1 is characterized in having a structure in which “a new search query created by adding the search key selected on the third window” is displayed on the first window, and the search for a desired patent document data file is retried based on the new search query, and the search can be retried until the desired patent document data is found or established as non-existent.

As described above, a search query (the first window), a list of the one or more patent document data files (the second window), and a list of the search keys (the third window) are simultaneously displayed on the same screen. Accordingly, it is possible to repeat a retrying of the search by associating the windows with each other and transmitting processing between the

units. Accordingly, by only switching the active window using a mouse or the like while referring to the three windows on the same screen, the user can operate the windows to retry a search many times without switching between contents being displayed on the screen. Therefore, the amended Claim 1 can achieve an excellent effect unique to the present application so that even inexpert users can perform searches.

Furthermore, the following effects unique to the present application can be achieved: Even inexpert users who are unfamiliar with such classification symbols as IPC, F1, and F-term employed in the patent search system can first perform keyword searching and then extract, as search keys, these classification symbols from data files that have resulted from the keyword searching. The inexpert users can then perform another search for data files based on the extracted classification symbols.

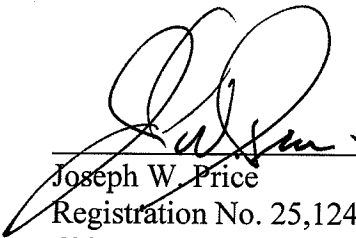
Further, expert users can fully utilize the classification symbols because the expert users can use, in searching for data files, even classification symbols that have been unfamiliar to them. Finally, the user only extracts search keys from prior confidential data files selected by the user.

It is believed that the case is now in condition for allowance and early notification of the same is requested.

If the Examiner believes that a telephone conference will help further the prosecution of this case, the undersigned attorney can be contacted at the listed telephone number.

Very truly yours,

SNELL & WILMER L.L.P.



Joseph W. Price

Registration No. 25,124

600 Anton Boulevard, Suite 1400

Costa Mesa, California 92626-7689

Telephone: (714) 427-7420

Facsimile: (714) 427-7799